

### **REMARKS**

Claims 51 and 60-75 are presently pending. Claims 51, 63, and 68 have been amended. Therefore, claims 51 and 60-75 remain pending in the present application.

### **Request for Continued Examination**

The Applicants are concurrently filing a Request for Continued Examination ("RCE") that accompanies this response.

Pursuant to 37 C.F.R. §§ 41.52, 1.198, and 1.114 and Manual of Patent Examining Procedure, Section 1214.07, applicants request that, upon entry of the RCE submitted herewith, the present application be reopened for prosecution.

### **35 U.S.C. § 112, Second Paragraph**

For the reasons previously set forth during the prosecution of this application and for those reasons set forth in the Applicant's Request for Rehearing of Decision on Appeal filed with the Board of Patent Appeals and Interferences on July 30, 2007, the Applicants respectfully disagree with the Board's new ground for rejection that claims 51 and 60-75 are indefinite.

However, to simplify the issues and to advance prosecution of this application, independent claims 51, 63, and 68 have been amended to remove the term "substantially uniform" from the phrase "substantially uniform array of irregularities." It is believed that these amendments will place this application on a quicker and less costly path to allowance, rather than filing an Appeal to the Federal Circuit.

With all due respect to the Board's Decision, the Applicants maintain that the previously pending claims were acceptable under 35 U.S.C. § 112. The specification discloses an acid-etched surface having a substantially uniform array of irregularities. One skilled in the art would surely understand that the acid-etched surface could not result in a "perfectly uniform" array of irregularities on a micron-level scale. Further, the figures in the specification do not show a surface having a "perfectly uniform" array of irregularities.

### **Previous Rejections Under 35 U.S.C. § 103**

The Applicants also respectfully submit that the presently pending claims are allowable over JP 3-146679 to Haruyuki et al ("Haruyuki"), U.S. Patent No. 4,826,434 to Krueger ("Krueger"), U.S. Patent No. 5,571,017 to Niznick ("Niznick"), or a combination thereof for at

least the reasons previously set forth in the Applicants' Appeal Brief Under 37 C.F.R. 1.192, which is incorporated by reference herein. More specifically:

1. Haruyuki's second step "smoothens" the underlying surface – it does not "roughen" it. Appeal Br., p. 7.
2. Niznick and Haruyuki do not teach all of the elements of claim 51. Appeal Br., p. 9.
3. Niznick and Haruyuki teach away from their combination. Appeal Br., p. 10-11.
4. Niznick teaches away from the claimed invention. Appeal Brief, p. 12.
5. Niznick and Haruyuki do not teach all of the elements of claim 63. Appeal Br., p. 13.
6. Niznick and Haruyuki do not teach all of the elements of claim 68. Appeal Br., p. 14.
7. Niznick and Haruyuki do not teach all of the specific elements of dependent claims 61, 67, and 72. Appeal Br., p. 15.
8. Dr. Porter's Declaration establishes secondary evidence of non-obviousness. Appeal Br., pp 15-16.

### Conclusion

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. The Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated. The Commissioner is authorized to charge any fees that may be required (except for payment of the issue fee) to Nixon Peabody LLP, Deposit Account No. 50-4181, Order No. 247168-000035USC1.

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Respectfully submitted,

By 

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